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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,847	06/13/2005	Jun Sakamoto	IPE-052	1538
20374 7590 04/08/2008 KUBOVCIK & KUBOVCIK SUITE 1105 1215 SOUTH CLARK STREET ARLINGTON, VA 22202				
EXAMINER				
MESH, GENNADIY				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
04/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,847

**Applicant(s)**

SAKAMOTO ET AL.

**Examiner**

GENNADIY MESH

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,8 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) 20-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8 and 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 18, 2008 has been entered.

Rejection is maintained as it was set forth in previous Office Action mailed on September 19, 2007, but altered due to amendment.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1,8 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.( US 6,365,659) in view of Naylor et al.( WO 97/47675) combine with Kato et al.( US 6,680,353).
- 1.1. Regarding Claims 1 and 18 Aoyama discloses polyester composition and films, including laminate ( see lines 10 – 26,column 11) , comprising preferably from 3ppm to 50 ppm of titanium oxide ( see lines 45-49,column 4 and), wherein particle may have equivalent circular diameter more than 1 micron( see line 36,column 3) and phosphorous in the preferable amount from 3 ppm to 100 ppm. Titanium particles are

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used as a polymerization catalyst and can be present as complex oxide with silicon – (see lines 30 – 40, column 4).

As it was discussed above Aoyama discloses that titanium oxide catalyst could have different structures( see lines 1-5, column 5) including alkoxy groups, but silent about specific groups as, for example, residue from hydroxycarboxylic acids as it claimed by Applicant.

However, use of titanium catalysts prepared by reaction of the titanium as alkyl titanate with lactic or citric acids taught by Naylor et al ( WO 97/47675) – see pages 11 and 12.

Naylor teach that this type of titanium catalyst is preferable for production of film or bottle grades polyester resins, because it allowed produce resin with low haze value and good color, due to elimination of precipitation inorganic titanium compounds as titanium dioxide ( see page 3, third paragraph).

Therefore, it would have been obvious to ordinary skill in the art at the time of the invention to use specific titanium catalyst per teaching of Naylor in order to obtain composition disclosed by Aoyama with better (low) haze and color ( white hue).

1.2. As it was discussed above Aoyama in view of Naylor disclosed use of phosphorus based compounds, but silent about specific compound as ethyl diethylphosphonoacetate.

However, Kato teach that this specific compound is preferable in view of "the excellent effects of coloring prevention and melt stability" – see lines 23-45,column 8.

Therefore, it would have been obvious to ordinary skill in the art at the time of the invention to use ethyl diethylphosphonoacetate in polyester resin composition in order to obtain polymer with good color and melt stability.

1.3. Regarding Claim 8: see Aoyama column 5, lines 1-5.

Regarding Claim 13: see Aoyama column 7, lines 3-9.

Regarding Claims 14 and 15 Aoyama discloses that composition can comprise alkaline earth metal, including magnesium, in preferable range of 10 ppm to 100 ppm see lines 19 – 30, column 6 and Table 1, Example 3.

Regarding Claim 16: as substantially same, composition disclosed by Aoyama in view of Naylor combine with Kato will have substantially same properties, including volume receptivity because it comprises same type and quantity of conductive particles.

2. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al. (US 6,365,659) in view of Naylor et al. (WO 97/47675) combine with Kato et al. (US 6,680,353) as it applied to claims 1, 8 and 13-18 above, and in further view of Uchida et al. (US 6,670,030).

As it was discussed above Aoyama in view of Naylor combine with Kato discloses use of the polyester composition for laminate films, but silent about magnetic recording laminated film.

However, polyester films routinely used for base layer of magnetic recording films.

For example, Uchida discloses that biaxial oriented laminate polyester film can be used for recording medium due to excellent running durability ( see abstract). Therefore, it would have been obvious to ordinary skill in the art at the time of the invention to use polyester composition disclosed Aoyama in view of Naylor combine with Kato for recording medium laminated film as it taught by Uchida.

***Response to Arguments***

Applicant's arguments with respect to claims 1.8 and 13-19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

**THIS ACTION IS NOT MADE FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gennadiy Mesh  
Examiner  
Art Unit 1796

/GM/

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796